

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Shawn Edward WIEDERIN <i>et al.</i>	Confirmation No.: 7867
Filed: April 17, 2001	Group Art Unit: 3629
Customer No.: 25537	Examiner: Casler, T.
Attorney Docket: CDR00010	

For: METHOD FOR CHARGING ON-LINE DIRECTORY ASSISTANCE SERVICES

REPLY BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450
Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed November 13, 2008.

I. STATUS OF THE CLAIMS

Claims 1-40 are pending and are on appeal.

II. GROUND OF REJECTION TO BE REVIEWED

Whether claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 are obvious under 35 U.S.C § 103 based on *Cox et al.* (US 2002/0115431) in view of *Gerszberg et al.* (6,052,439) and *BOC*?

Whether claims 2-4, 10-12, 18-20, 26-28, and 34-36 are obvious under 35 U.S.C § 103 based on *Cox et al.* (US 2002/0115431) in view of *Gerszberg et al.* (6,052,439) and further in view of *Shah et al.* (US 6,212,506)?¹

III. ISSUES

1. Whether *Cox et al.* teaches away from making the combination proposed by the Examiner?
2. Whether the Examiner is justified on relying on the catch-all phrase of paragraph 47 of *Cox et al.* regarding modifying the teachings of the reference, as a basis for justifying any and all modifications of the teachings of the reference?
3. Whether the Examiner may dismiss, as not relating to specific claim language, Appellants' argument that the objective of *Cox et al.* is to impose the responsibility for determining charges to be levied upon the cellular carrier, when the argument goes to a showing of a "teaching away," and hence, an improper combination, rather than to any specific claim language?

IV. ARGUMENT

Appellants maintain and rely on the arguments set forth in the principal Appeal Brief of June 20, 2007, which are incorporated herein by reference. Additionally, Appellants provide the following comments with regard to the Examiner's response in the Examiner's Answer:

1. The Examiner states that Appellants argue *Cox et al.* individually as not teaching transmitting more than one directory listing, when it is *BOC* that is relied on for such a

¹ Appellants note the inconsistency in the omission of a reference (*BOC*) in the statement of rejection of dependent claims when the claims from which they depend are rejected based on a combination including that reference.

teaching. Appellants do not argue *Cox et al.* individually, and understand that the rejection is based on a combination of references. What Appellants are arguing is that there is no dispute that *Cox et al.* fails to teach transmitting more than one directory listing and, so, it must be combined with another reference(s). However, because *Cox et al.* teaches away from the combination (because a modification of *Cox et al.* would undermine the basis of *Cox et al.* which is to make the cellular carrier, and not the provider of the directory assistance service, responsible for any charges to be rendered), the combination itself is improper.

2. The Examiner contests Appellants' "teaching away" argument by indicating that *Cox et al.* "would have to explicitly state that the Cellular carrier can be the only embodiment for which will work" [sic] (Examiner's Answer-pages 7-8). The Examiner then notes that paragraph 47 of *Cox et al.* indicates that the preferred embodiment "can easily be modified without departing from such principles" (Examiner's Answer-page 8). Respectfully, the Examiner's reasoning is flawed. Appellants are aware of no authority that countenances the Examiner's proposed rule that a "teaching away" requires an "explicit" statement in a reference that no other embodiment "will work," and Appellants request the Examiner to cite such legal authority. Moreover, the Examiner's reliance of paragraph 47 of *Cox et al.* is misplaced as this is a general catch-all declaration that the examples shown "can be modified in arrangement and detail without departing from such principles," with no specifics, especially how/why the teachings of the reference would be modified to change levying of charges by the cellular carrier to levying the charges by the provider

of the directory assistance services. There is absolutely no indication therein of what types of modifications are envisioned. Specifically, again, there is no suggestion therein as to modifying the **only** embodiment disclosed wherein the cellular carrier, and not the provider of the directory assistance service, is responsible for any charges to be rendered. In other words, there is nothing within paragraph 47 of *Cox et al.* suggesting that the provider of the directory assistance service might be responsible for rendering charges, and the Examiner's desire to make such a modification, based on paragraph 47, can only arise from impermissible hindsight gleaned from Appellants' own disclosure.

3. The Examiner argues "that the claims do not claim or limit who is doing the charging for the services" (Examiner's Answer-page 9). Respectfully, the Examiner misses the point. The argument about *Cox et al.* disclosing that the cellular carrier, and not the directory assistance provider, is levying the charges, goes to the propriety of the combination, not necessarily to the instant claim language itself. That is, since *Cox et al.* discloses only that the cellular carrier levies the charges for directory assistance, therefore teaching away from the provider of the directory assistance services levying the charges, there would have been no reason to modify the reference in the manner proposed by the Examiner. In fact, such a modification would completely undermine the objective of *Cox et al.*, which imposes the responsibility to rate the calls and determine the charge to be levied upon the cellular carrier. Thus, Appellants' argument goes to the impropriety of the rationale for making the combination and not to any specific claim language.

III. CONCLUSION AND PRAYER FOR RELIEF

The Examiner's combination is improper for the reasons set forth in the principal Appeal Brief and for the additional reasons set forth above. Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

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December 3, 2008
Date

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